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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,995	10/16/2003	Navin Geria	6579-408-1	7466

7590 08/01/2006

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EXAMINER	
GOLLAMUDI, SHARMILA S	

ART UNIT	PAPER NUMBER
1616	

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/686,995	GERIA, NAVIN	
	Examiner	Art Unit	
	Sharmila S. Gollamudi	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 May 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt of Remarks filed 5/26/06 is acknowledged. Claims **1-5** are pending in this application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The rejection of claims 1-5 under 35 U.S.C. 103(a) as being unpatentable over Edwards et al (5,523,081) in view of Buerger et al (5985299) is maintained.

Edwards teaches a cosmetic composition for shaving of the skin comprising from (a) 40-90% by weight of water; (b) from 4-25% by weight of water-soluble soap; (c) from 0.5-12% by weight of an inert volatile liquid agent, (d) optionally from 0.01-5% by weight of water-soluble gelling agent, and (e) 0.01-15% by weight of a polyorganosiloxane micro-emulsion, the micro-emulsion having an average particle size of less than 0.14 microns. See column 2, lines 1-10. Preferred soaps include the water-soluble stearate and palmitates soaps, such as potassium, ammonium, sodium, and the soluble amine soaps of commercial stearate acid and palmitic acid. See column 2, lines 40-55.

Edwards teaches the inert volatile liquid agent used in the aerosol form of the composition should be suitable to function as an aerosol propellant gas and can be selected from a wide variety of the propellants known in the aerosol industry. Suitable inert inorganic gases such carbon dioxide, nitrogen, argon and air. Suitable examples of liquid or liquefied propellant agents include propane, n-butane and iso-butane, or halogenated with fluorine or chlorine, such

as monochlorotrifluoromethane, dichlorodifluoromethane, trichloromonofluoromethane, and similar chlorofluorohydrocarbons preferably with from 1 to 3 carbon atoms. See column 3, lines 25-50. Suitable such post-foaming agents for use in the gel compositions are liquids or liquefiable and include saturated aliphatic hydrocarbons having from 4-6 carbon atoms, such as butanes, pentanes and hexanes; partially or wholly halogenated hydrocarbons, such as trichlorotrifluoro ethane. See column 4, lines 5-40 and note examples.

The gelling agents used for post-foaming gel type are water-soluble derivatives of naturally occurring substances such as cellulose, sucrose, and glucose. Preferred gelling agents include the co-polymers of acrylic acid and a polyally sucrose, and reaction products of cellulose or glucose with acids or alkaline oxides. See column 3, lines 5-25.

Lastly, Edwards teaches the products may additionally comprise other optional ingredients, such as humectant, skin fresheners, lather stabilizers, coloring materials, dyes, perfumes, **preservatives, bactericides, bacteriostats**, and other components routinely used in such compositions. See column 6, lines 25-32.

Edwards does not specify the use of instant dichlorobenzyl alcohol.

Buerger teaches a pore cleaning formulation. Buerger teaches the formulation includes one or more preservatives to stabilize the composition and/or prevent the growth of bacteria, and/or molds. The reference teaches a variety of suitable materials known in the art of cosmetic formulation may be used in this context, for example, methyl paraben, benzalkonium chloride, benzylparaben, **dichlorobenzyl alcohol**, DMDM hydantoin, imidazolidinyl urea, isopropylparaben, quatemium-15, sodium benzoate, etc. The preservative preferably comprises

from 0-2% wt of the overall composition on a dry basis, more preferably 0-1% wt, and most preferably around 0.5% wt. See column 6, lines 29-41.

It would have been obvious for one of ordinary skill in the art at the time the invention was made to combine the teachings of Edwards et al and Buerger et al and utilize dichlorobenzyl alcohol as the preservative in Edwards's composition. One would have been motivated to do so since Buerger teaches conventional preservatives known and used in the cosmetic art, such as dichlorobenzyl alcohol, to prevent the growth of bacteria and molds in the composition. Therefore, a skilled artisan would have been motivated to utilize a conventional preservative such as instantly claimed dichlorobenzyl alcohol, in the composition to extend its shelf life. Further, a skilled artisan would have expected similar results since Edwards teaches utilizing routine adjuvants known in the cosmetic art such as preservatives, stabilizers, etc.

Response to Arguments

Applicant argues that the primary reference is directed to a shaving product and the secondary reference is directed to a cosmetic pore cleaning composition. It is argued that the combination of two different compositions is improper since Buerger's composition is applied, dried, and then peeled off the skin surface.

Applicant's arguments filed 5/26/06 have been fully considered but they are not persuasive. Firstly, the examiner notes that the two compositions have different intended uses; however this does not make the references non-analogous. The examiner points out that both references are directed to cosmetic compositions that are applied to the skin without any toxicity and thus are considered to be analogous.

Secondly, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In instant case, the obviousness rejection is based on the use of dichlorobenzyl alcohol as a preservative in cosmetic compositions. Edwards suggests the use of ***routine*** adjuvants known in the cosmetic art such as preservatives and stabilizers. Buerger teaches ***conventional*** preservatives known and used in the cosmetic art include dichlorobenzyl alcohol, to prevent the growth of bacteria and molds in the composition. The fact that the one cosmetic is used for shaving and the other cosmetic is used for cleansing the skin does not change the function of a preservative in the composition. In other words, the intended use of the product is immaterial to the function of a preservative in a composition, i.e. the preservative will "preserve" the cosmetic regardless. Thus, the instant obviousness rejection is not based on the if one would bodily incorporate Buerger's composition of Buerger into Edward's composition, the rejection is based on the obviousness based on the conventional use of dichlorobenzyl alcohol as a preservative.

Lastly, the fact that the prior art teaches the use of dichlorobenzyl alcohol for a different purpose than applicant is irrelevant since the instant claims are directed to *product* claims and the prior art teaches dichlorobenzyl alcohol in the same weight percent as claimed.

It noted that applicant's arguments are against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re*

Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant has not addressed the examiner's motivation on the combination of references and thus the arguments are considered unpersuasive.

The rejection of claims 1-5 under 35 U.S.C. 103(a) as being unpatentable over Edwards et al (5,523,081) in view of Moran et al (5,523,017) is maintained.

Edwards teaches a cosmetic composition for shaving of the skin comprising from (a) 40-90% by weight of water; (b) from 4-25% by weight of water-soluble soap; (c) from 0.5-12% by weight of an inert volatile liquid agent, (d) optionally from 0.01-5% by weight of water-soluble gelling agent, and (e) 0.01-15% by weight of a polyorganosiloxane micro-emulsion, the micro-emulsion having an average particle size of less than 0.14 microns. See column 2, lines 1-10. Preferred soaps include the water-soluble stearate and palmitates soaps, such as potassium, ammonium, sodium, and the soluble amine soaps of commercial stearate acid and palmitic acid. See column 2, lines 40-55.

Edwards teaches the inert volatile liquid agent used in the aerosol form of the composition should be suitable to function as an aerosol propellant gas and can be selected from a wide variety of the propellants known in the aerosol industry. Suitable inert inorganic gases such carbon dioxide, nitrogen, argon and air. Suitable examples of liquid or liquefied propellant agents include propane, n-butane and iso-butane, or halogenated with fluorine or chlorine, such as monochlorotrifluoromethane, dichlorodifluoromethane, trichloromonofluoromethane, and similar chlorofluorohydrocarbons preferably with from 1 to 3 carbon atoms. See column 3, lines 25-50. Suitable such post-foaming agents for use in the gel compositions are liquids or liquefiable and include saturated aliphatic hydrocarbons having from 4-6 carbon atoms, such as

butanes, pentanes and hexanes; partially or wholly halogenated hydrocarbons, such as trichlorotrifluoro ethane. See column 4, lines 5-40.

The gelling agents used for post-foaming gel type are water-soluble derivatives of naturally occurring substances such as cellulose, sucrose, and glucose. Preferred gelling agents include the co-polymers of acrylic acid and a polyally sucrose, and reaction products of cellulose or glucose with acids or alkaline oxides. See column 3, lines 5-25.

Lastly, Edwards teaches the products may additionally comprise other optional ingredients, such as humectant, skin fresheners, lather stabilizers, coloring materials, dyes, perfumes, preservatives, bactericides, bacteriostats, and other components routinely used in such compositions. See column 6, lines 25-32.

Edwards does not specify the use of instant dichlorobenzyl alcohol.

Moran et al teach solid cleansing bars including shaving bars. See examples 5-6. The composition comprises detergents such as lauryl sulfate. See column 2, lines 10-11. Moran teaches the use of adding to the composition colors, fragrances, medicaments, astringents, deodorants, antidandruff substances, and antibacterials agents in the amount of 0.5-5% and specifically dichlorobenzyl alcohol in the amount of 0.2-0.5%. See column 6, line 55 to column 7, line 3.

It would have been obvious for one of ordinary skill in the art at the time the invention was made to combine the teachings of Edwards et al and Moran et al and utilize dichlorobenzyl alcohol as the bactericide in Edwards's composition. One would have been motivated to do so since Moran teaches the use of antibacterials agents such as instant dichlorobenzyl alcohol, in cleansing composition such as shaving preparations. Therefore, a skilled artisan would have been

motivated to utilize a instantly claimed dichlorobenzyl alcohol in the composition for its antibacterial properties. Further, a skilled artisan would have expected similar results since Edwards teaches additionally utilizing of routine adjuvants known in the cosmetic art such as bactericides.

Response to Arguments

Applicant argues Edwards and Moran are in non-analogous fields since Edwards teaches a cosmetic shaving composition and Moran teaches a solid bar that is used for cleansing or shaving. Applicant argues that Moran does not teach the use of 40-90% water, 4-25% of a water-soluble soap, and 0.5-12% of a volatile liquid agent. Applicant argues that Edwards teaches an aerosol or gel formulation and Moran teaches a solid bar composition and thus the two fields are mutually exclusive.

Applicant's arguments filed 5/26/06 have been fully considered but they are not persuasive. Firstly, the examiner notes that the two compositions have different intended uses; however this does not make the references non-analogous. The examiner points out that both references are directed to cosmetic compositions that are applied to the skin without any toxicity and thus are considered to be analogous.

Secondly, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In instant case, the examiner points out that Edwards is only lacks the teaching of dichlorobenzyl alcohol. Moreover, the

secondary reference need not teach 40-90% water, 4-25% of a water-soluble soap, 0.5-12 of a volatile liquid agent since Edwards in not deficient in this sense. Thus, obviousness rejection is based on the use of dichlorobenzyl alcohol as an antibacterial in shaving compositions. Edwards suggests the incorporation of routine, cosmetic adjuvants such as bactericides and Moran teaches the use of antibacterial agents such as instant dichlorobenzyl alcohol in shaving preparations. Thus, a skilled artisan would have been motivated to utilize the instantly claimed dichlorobenzyl alcohol in the composition for its antibacterial properties. The fact that the one cosmetic is in a gel or aerosol form and the other composition is in a solid form does not change the function of the antibacterial in the composition. In other words, the intended use or the final form of the product is immaterial to the function of an antibacterial, i.e. the antibacterial will still function as a biocide in the cosmetic regardless. Thus, the instant obviousness rejection is not based on the if one would bodily incorporate Moran's composition into Edward's composition, the rejection is based on the obviousness based on the conventional use of dichlorobenzyl alcohol as a antibacterial. Lastly, is noted that applicant's arguments are against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant has not addressed the examiner's motivation on the combination of references and thus the arguments are considered unpersuasive.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/06153 to Moldovanyi in view of Schraufstatter (2,945,782).

Moldovanyi teaches surface-active formulations for the disinfection and cleansing of skin and hands. The formulation comprises (a) 0.01-5% of a microbiocidal active agent of Formulas 1-7; (b) 0.1-25% of one or more hydrotrophic agent; (c) 0-10% surface active agents or a soap; (d) 0-8% of a fatty acid salt; (e) 0-50% dihydric alcohol; (f) 0-70% of a monohydric alcohol; and water to balance. See abstract. The illustrative microbiocidal active agents of formula 3 are benzyl alcohol; 2,4- or 3,5-, or 2,6-dichlorobenzyl alcohol. See page 3. The surface-active agent may be a anionic such as sulfates, alkylamide sulfates, alkylamide ether sulfates, alkylaryl polyether sulfunates, alkylaryl sulfonates, alkane sulfonates, etc. See page 7-8. Alkali metal salts of lauryl ether sulfate are preferred. See page 9. The monohydric alcohol taught is ethanol, propanol, and isopropanol (inert volatile liquid). See page 10.

Specifically example 11 teaches 1 part 2,4-dichlorobenzyl alcohol; 4 parts sodium lauryl sulfate (water-soluble soap); 5 parts sodium cumene sulfonate; 1 part propylene glycol; 8 parts citric acid monohydrate; and water to balance (81%). Example 7 uses 12% ethanol with 1% of the microbicidal agent of formula 6.

Although Moldovany teaches the optional use of a monohydric alcohol in the amount of 0-50% which encompasses ethanol and isopropanol, the reference lacks the specific teaching of the inert volatile liquid (ethanol or isopropanol) with the instantly claimed microbiocidal agent (dichlorobenzyl alcohol).

Schraufstatter teaches disinfectant composition comprising dichlorobenzyl alcohol. Schraufstatter teaches the use of alkylsulfates or sulfonates, aralkylsulfonates, alkylarylsulfonate and monovalent or polyvalent alcohols such as ethanol, isopropanol, glycols, and polyglycol are dissolving agents for halogen containing arylalkanols. See column 1, lines 38-45.

It would have been obvious for one of ordinary skill in the art at the time the invention was made to combine the teaching of Moldovanyi's and Schraufstatter and utilize ethanol or isopropanol, both of which are inert volatile liquids, as the solvent in example 11. One would have been motivated to do so since Schraufstatter teaches that ethanol, isopropanol, or glycols may be used as the solvent for dissolving halogen-containing arylalkanols (dichlorobenzyl alcohol). Thus, one would have been motivated to substitute the propylene glycol with as ethanol/isopropanol as the solvent of choice since Schraufstatter teaches that all three are used as solvents for dichlorobenzyl alcohol, i.e. all are functional equivalents in acting as dissolving agents for dichlorobenzyl alcohol. Therefore, a skilled artisan would have expected similar results by utilizing ethanol/isopropanol since the prior art establishes that propylene glycol the solvent used in Moldovanyi and ethanol/isopropanol are functional equivalents.

Note that "shaving" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Response to Arguments

Applicant argues that the term "shaving" must be given weight since it limits the claim to composition that are applied to the skin. It is argued that the examiner has not applied any meaning to the preamble. Applicant argues Moldovanyi teaches a disinfecting composition for the hands. Applicant argues that Schraufstatter teaches a disinfectant composition for

disinfecting hands, linens, stables, tools, etc. Thus, applicant argues none of the references teaches dichorobenzyl alcohol and an inert volatile liquid in a shaving composition.

Applicant's arguments filed 5/26/06 have been fully considered but they are not persuasive. Firstly, the examiner has given weight to the preamble in terms that the composition must be capable of being applied to the skin and non-toxic to the skin. As acknowledged by applicant, Moldovanyi teaches a disinfecting composition for the hands and although Schraufstatter teaches a disinfectant composition for disinfecting linens, stables, and tools, Schraufstatter teaches the use of the composition for disinfecting hands. Thus, clearly both references are applied to the skin and thus meet the criteria that the composition must be capable of being applied to the skin. It should be noted that the instant claims are directed to a product and a recitation of the intended use of the claimed invention must result in **a structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. **If the prior art structure is capable of performing the intended use, then it meets the claim.** In instant case, the intended use does not provide any structural meaning to the claims.

Therefore, the instant rejection is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sharmila S. Gollamudi
Examiner
Art Unit 1616